

REMARKS

Entry of this Amendment, reconsideration and allowance of the above-captioned patent application are respectfully requested. This application relates to aminoalkylphosphonates and related compounds as edg receptor agonists.

Claims 1 to 4, 6 to 17, 28 and 29 are currently pending in the application. Claims 1 to 4 (in part), 6 (in part), 7, 8 to 11 (in part), 12, 13, 14 (in part), 15 (in part), 16, 17, 28 and 29 (in part) have been withdrawn by the Examiner as directed to non-elected subject matter. Claims 1 to 4, 6, 8 to 11, 14, 15 and 29 stand rejected under 35 U.S.C. § 101 as allegedly not supported by either a credible utility or well established utility. Claims 1 to 4, 6, 8 to 11, 14, 15 and 29 stand rejected under 35 U.S.C. § 103 as obvious over U.S. 6,437,165 ("Mandala"). Claims 1 to 4, 6, 8 to 11, 14, 15 and 29 stand rejected for non-statutory obviousness-type double patenting over Claims 1 to 11 of Mandala. No claim has been allowed.

This amendment amends Claims 1, 6 to 8, 10 and 15. Support for adding -SO₂CH₃ to the definition of A in Claim 1 is found in Example 6. A minor amendment is being made to Claim 15. The remaining amendments are to remove non-elected subject matter. Upon entry of this Amendment, the claims in the application will remain Claims 1 to 4, 6 to 17, 28 and 29.

Unity of Invention

The Examiner has outlined the scope of the invention that was examined on the merits on pages 3 and 4 of the Office Action. The remaining subject matter has been withdrawn from consideration. However, the scope of the invention examined on the merits was revised pursuant to a telephone conversation between the Examiner and the undersigned on April 27, 2007. Applicants have amended the claims accordingly and deleted all non-elected subject matter from the product claims.

Upon a finding of allowability by the Examiner of the product claims, Applicants respectfully request that the method of treatment Claims 16, 17 and 28 be considered for rejoinder pursuant to M.P.E.P. § 821.04.

Claim Rejections – 35 U.S.C. § 101

Applicants respectfully disagree with the Examiner that Claims 1 to 4, 6, 8 to 11, 14, 15 and 29 lack a credible asserted utility or a well established utility under 35 U.S.C. § 101. One skilled in the art would in no way doubt the utility as asserted by the Applicants. There is no requirement of specific utility data to support the assertion that the claimed compounds possess activity as S1P₁/Edg1 receptor agonists in order to comply with 35 U.S.C. § 101.

Although Applicants disagree that data is required, Applicants submit herewith a Declaration of Suzanne M. Mandala providing in vitro data for Examples 1 to 37 in order to advance prosecution of the application. This data demonstrates that Applicants statements of asserted utility are true.

Overcoming the 35 U.S.C. §101 rejection also overcomes the rejection under 35 U.S.C. §112, first paragraph. Applicants submit that the specification as filed fully complies with 35 U.S.C. §§ 101 and 112, first paragraph.

Claim Rejections – 35 U.S.C. § 103

Applicants submit herewith a Statement Establishing Common Ownership To Disqualify A Patent As Prior Art Under 35 U.S.C. § 103(c) pursuant to M.P.E.P. § 706.02(l)(2) as U.S. Patent No. 6,437,165 is alleged to constitute prior art under 35 U.S.C. § 102(e). Withdrawal of the obviousness rejection is respectfully requested.

Double Patenting

Applicants submit herewith a Terminal Disclaimer to overcome the obviousness-type double patenting rejection. Withdrawal of the double patenting rejection is respectfully requested.

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Information Disclosure Statement

The Examiner did not consider three references listed in the Information Disclosure Statement dated May 4, 2005 for the reason that copies were not provided by the Applicants. Copies of these references are being submitted herewith and cited on a new Form PTO-1449 (substitute).

Conclusion

Applicants submit that the application is in condition for allowance and passage thereto is earnestly requested. Any additional fees required in connection with this Amendment may be taken from Merck Deposit Account No. 13-2755. The Examiner is invited to contact the undersigned attorney at the telephone number provided below if such would advance the prosecution of the case.

Respectfully submitted,

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Date: April 27, 2007



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Richard J. Budhu, et al.

Serial No.: 10/505,257 Case 21044P

Art Unit:
1626

Filed: August 20, 2004

Examiner:
Chu, Yong Liang

For: AMINOALKYLPHOSPHANATES AND RELATED
COMPOUNDS AS EDG RECEPTOR AGONISTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT ESTABLISHING COMMON OWNERSHIP
TO DISQUALIFY A PATENT AS PRIOR ART UNDER 35 U.S.C. § 103(c)

Sir:

U.S. Patent No. 6,437,165 and U.S. Patent Application No. 10/505,257 were, at the time the invention of U.S. Patent Application No. 10/505,257 was made, owned by or subject to an obligation of assignment to Merck & Co., Inc., Rahway, New Jersey.

Respectfully submitted,

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on the date appearing below.

MERCK & CO., INC.

By Janet Y. Date 4/27/07

Date: April 27, 2007

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